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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT C. NANCE

Appeal 2009-001325
Application 10/086,263
Technology Center 2100

Decided: June 29, 2009¹

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-23, which are all the pending claims. An oral hearing was held on May 20, 2009. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellant claims a method and system for locating cellular phone numbers by creating a directory of cellular phone users with their corresponding cellular phone numbers. (Spec. 1: 4-8.)

Representative Claims

1. A method for locating cellular phone numbers comprising, in combination, the steps of:

compiling a list of cellular phone users from at least one cellular phone provider;

compiling a list of corresponding cellular phone numbers of said cellular phone users;

creating a database of said list of said cellular phone users and said list of corresponding cellular phone numbers of said cellular phone users;

publishing said database in at least one of an electronic network, a CD-ROM, and a phone book; and

a user locating at least one of said cellular phone numbers by searching said database.

21. A method for providing access to cellular phone numbers comprising, in combination, the steps of:

compiling a list of cellular phone numbers from at least one cellular provider; and

providing in at least one of an electronic network [,] a CD-ROM, and a phone book available to phone users at least a portion of the list of compiled cellular phone numbers.

Prior Art

Smith	US 6,173,045 B1	Jan. 9, 2001
Shaffer	US 5,901,214	May 4, 1999

Examiner's Rejections

Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith and Shaffer.

Claim Groupings

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of claims 1 and 21. *See* 37 C.F.R. § 41.37(c)(1)(vii).

FINDINGS OF FACT

Smith

Smith describes an electronic phone book 10 (Fig. 1a) having a display 12 and soft buttons 14, for user interaction. Smith col. 2, ll. 20-44.

The electronic phone book 10 further comprises a floppy disk drive 16 (Fig. 1b) and a CD ROM drive 18. Smith col. 2, ll. 45-47. The drives 16 and 18 may be used to store information locally within the electronic phone book 10. *Id.*, ll. 56-65.

The electronic phone book 10 may communicate with a central office of the telephone company whereby phone numbers may be retrieved and updated in the local drives 16 and 18. Smith col. 2, l. 66 - col. 3, l. 4.

The user may also find telephone numbers by searching a database of telephone listings at the telephone company's central office. Smith col. 3, l. 59 - col. 4, l. 11; Figs. 3c, 3d.

Shaffer

A 10 digit telephone number comprises a 3 digit area code, a 3 digit exchange, and a 4 digit line number. Shaffer col. 7, ll. 29-33.

A 10 digit telephone number can be assigned to a cellular phone, with the number independent of location within the assigned area code (*id.* at ll. 43-46), which indicates there is no functional difference between 10 digit telephone numbers, whether assigned to cellular phones or to other types of telephones.

Whether a telephone number is associated with a cellular phone or another type of phone may be distinguished by a separate database entry of a telephone type code, rather than the number itself. Shaffer col. 43, ll. 22-44. (Ans. 4.)

Shaffer's system can accommodate cellular phone numbers. (*See also* App. Br. 10 (“[T]he system of Schaffer [sic] is sufficiently flexible to incorporate cellular phone numbers”); App. Br. 13 (“Applicant’s claimed invention may potentially be practiced using elements taken from non-cellular directory assistance technology.”))

PRINCIPLES OF LAW

The *content* of nonfunctional descriptive material is not entitled to weight in the patentability analysis. *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory. . . . Nor does he seek to patent the content of information resident in a database.”). *See also Ex parte Nehls*, 88 USPQ2d 1883 (BPAI 2008); *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Fed. Cir. Appeal No. 2006-1003, *aff’d* Rule 36 Jun. 12, 2006); *Manual of Patent Examining Procedure* (MPEP) § 2106.01 (Eighth ed., Rev. 7, Jul. 2008).

“[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)). The operative question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

ANALYSIS

Appellant contends in the Appeal Brief (at 9) that Smith “makes no reference whatsoever” to using the device to search or locate wireless or cellular numbers.

Appellant’s observation is not necessarily true. Smith refers to accessing central office databases for “telephone” or “phone” numbers. *See* Smith col. 2, l. 66 - col. 3, l. 4. As evidenced by Shaffer, however, a wireless or cellular phone is a species of “phone” that may be assigned the same type of ten-digit number as that assigned to a landline phone. *See*

Shaffer col. 7, ll. 26-50. Smith teaches retrieving names and phone numbers (e.g., Fig. 3b) from a central office database that does not distinguish the particular type of telephone to which the number is assigned. It would seem obvious for a phone company to provide whatever phone number that belongs to a particular person, whether wireless, cellular, or landline, especially if the company provides both cellular and landline service and the customer elects that the number or numbers be published. Moreover, we observe that the claims under review (1 and 21) do not preclude landline-based phone numbers being mixed (e.g., in the same database) with the cellular phone numbers.

In any event, as the Examiner notes (Ans. 9 and 11), and Appellant does not address in either brief, the numbers in a database (claim 1), or provided, for example, in an electronic network (claim 21), represent nonfunctional descriptive material that carries no weight in the analysis of the claims over the prior art. The numbers, although called “cellular” in the claims, do not distinguish between whether a particular number may be assigned to a cellular phone or to a landline phone.

To the extent that the claim 1 and claim 21 steps of compiling a list “of cellular phone users” and (claim 1) “corresponding cellular phone numbers” might represent acts that are functionally different from compiling a list of landline phone users and the corresponding landline phone numbers, Appellant seems to acknowledge that similar steps have been performed at least with respect to landline users and corresponding phone numbers. A (paper) phone book teaches as much, even assuming that not one of the phone numbers in the book is a number assigned to a cellular phone. The improvement of gathering phone numbers assigned to cellular phones, as opposed to the gathering of phone numbers assigned to landline phones,

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represents no more than the predictable use of prior art elements according to their established functions, and thus would have been obvious. *See KSR*, 550 U.S. at 417. Appellant has provided no evidence to show that compiling a list of cellular phone users and corresponding cellular phone numbers was “uniquely challenging or difficult for one of ordinary skill in the art.”

Leapfrog Enters., Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 419).

Appellant alleges (e.g., App. Br. at 12) that a directory of cellular numbers does not exist, or at least that the applied references do not demonstrate the existence of such a directory.

Appellant seems not to appreciate the breadth of the claims brought on appeal. Claim 21, for example, would not distinguish over a cellular phone company maintaining a list of the phone numbers assigned to corresponding phones. Presumably, tracking phone usage for service and billing purposes would be important for survival as a cellular phone company. As computers and electronic databases were well known and widely used at the time of invention (March 4, 2002, on this record), one would expect that a cellular phone company would have maintained phone numbers in a database accessible over an electronic network. Perhaps there were cellular phone companies prior to the date of invention that eschewed modern technology (such as cellular phones) and kept only paper records. Claim 21 also covers that contingency, however, in that “at least of portion of the list” might be provided in a “phone book available to phone users.” We expect that most, if not all, employees of cellular phone companies at the time of invention had used a phone at some point in life, and where thus “phone users.” A few, perhaps, even owned one.

Claim 1 is more comprehensive than claim 21, in reciting the compilation of lists of both cellular phone users and corresponding phone numbers, and creating a database based on that information. Claim 1, however, also seems not to distinguish over methods presumably used by a 21st century cellular phone company in the normal course of business. A “user” locating at least one of the cellular phone numbers by searching the database in the final step of claim 1 does not distinguish over a cellular phone company database user (i.e., employee) who would occasionally need to find the cellular phone number assigned to a customer, and the customer matched to a cellular phone number, assuming *arguendo* that the company intended to continue doing business as a cellular phone service.

Being not persuaded of error in the rejection, we sustain the Examiner’s § 103(a) rejection of claims 1 and 21. Claims 2-20, 22, and 23 fall with claim 1 or claim 21.

Appellant’s representative at the oral hearing advanced several new arguments that had not been presented to the Examiner in the Appeal Brief or the Reply Brief. As the arguments were not properly before the Examiner, such that we might have had benefit of the Examiner’s views on the arguments in reaching our decision in this appeal, we have considered only those arguments presented by Appellant in the briefs. *See* 37 C.F.R. § 41.47(e)(1): “At the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief except as permitted by paragraph (e)(2) of this section.” Paragraph (e)(2) of the relevant section provides: “Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.” *See also* 37 C.F.R.

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§ 41.37(c)(1)(vii) (“Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.”).

DECISION

The rejection of claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Smith and Shaffer is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

PEB

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